

### Remarks

This is in response to the Office Action mailed July 8, 2004, wherein the Examiner rejected claims 1-13.

At page 2 of the Office Action, the Examiner rejected claims 1-13 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,425,442 to Latiolais et al in view of either U.S. Patent No. 3,689,110 to Ferguson or U.S. Patent No. 4,426,162 to Tsuchiya et al. The Examiner's rejection is respectfully traversed. The determination of obviousness must be based on the basic factual inquiries identified in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (1966), which are (1) the scope and content of the prior art, (2) differences between the prior art and the claims at issue, and (3) the level of ordinary skill in the art.

In order to satisfy a *prima facie* case of obviousness, the relevant prior art must contain some teaching, suggestion or incentive that would have motivated an artisan to modify the reference. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The relevant prior art must teach or suggest all of the limitations of the claims without the slightest recourse to the teachings in the application. *Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200, 1207-08, 18 U.S.P.Q.2d 1016, 1022 (Fed. Cir. 1991). The proper test is whether "the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success." *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). The Examiner may not reject claims based on combinations of art from any source, and can only do so if the art utilized is within the appropriate scope of the prior art.

The combination of elements from non-analogous sources, in a manner that reconstructs the Applicants' invention only with the benefit of hindsight, is insufficient to present a *prima*

*facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1447, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992). The combination suggested by the Examiner utilizes art that falls well outside the appropriate scope of art.

There are two considerations in determining whether a prior art reference is within the appropriate scope of prior art: (1) whether the reference is from the applicant's field of endeavor; and (2) if not, whether the reference is still reasonably pertinent to the particular problem with which the inventor was concerned. MPEP § 2141.01(a); *Oetiker*, 24 U.S.P.Q.2d at 1445; *In re Clay*, 966 F.2d 656, 658-59, 23 U.S.P.Q.2d 1058, 1060 (Fed. Cir. 1992).

In his rejection, the Examiner cites either Ferguson '110 or Tsuchiya '162 (when viewed in conjunction with Latiolais '442) as the basis for rejection of the present claims under 35 U.S.C. § 103(a). Ferguson '110 and Tsuchiya '162 are clearly not in Applicants' field of endeavor. The particular problem with which Applicants were concerned relates generally to drilling and completion techniques for downhole wells, and more particularly to methods and apparatus for limiting the rotation of cementing plugs being drilled out of the plugs.

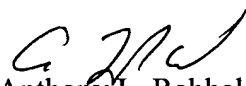
Tsuchiya '162 is not in the field of downhole drilling and is not concerned with limiting rotation of cementing plugs. Tsuchiya '162 relates to a rotor shaft for use in a steam turbine (Col. 1, lns. 5-8), and is concerned with providing a rotor shaft with high reliability and good bearing properties, and more particularly with providing a rotor shaft made of a Cr alloy steel having a high Cr content. (Col. 1, lns. 52-68 and col. 2, lns. 1-5). Nowhere does Tsuchiya '162 disclose anything pertinent to the rotation of cement plugs used in downhole drilling, or limiting the rotation of cement plugs. Accordingly, Tsuchiya '162 cannot properly be used as a reference to reject the claims of the present invention.

Similarly, Ferguson '110 is not in Applicants' field of endeavor and is not concerned with Applicants' particular problem. As disclosed, Ferguson '110 relates to plumbing, pipe and tube fittings. (Col. 1, lns. 3-5). Ferguson's invention generally focuses on providing a leak-proof encasement used for coupling a variety of plumbing, pipe and tube fittings. Ferguson is completely unrelated to wellbore completion and does not remotely address the problem of limiting the rotation of cementing plugs being drilled out of a well. Consequently, Ferguson '110 is non-analogous art and cannot be used to defeat the present invention.

In view of the foregoing, the Examiner has failed to present a *prima facie* case of obviousness under 35 U.S.C. § 103(a). The Examiner improperly relied on two pieces of non-analogous art. Accordingly, Applicants respectfully request reconsideration, and further that the Examiner withdraw the rejection of claims 1-13.

The Examiner is invited to contact the below signed attorney should any questions arise concerning this response. This is intended to be a complete response to the Office Action mailed July 8, 2004.

Respectfully submitted,

  
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